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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/774,321
Filing Date: February 06, 2004
Appellant(s): LIN ET AL.

Nick P. Patel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 April 2008 appealing from the Office action mailed 2 January 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2005/0097059 A1	SHUSTER	5-2005
2004/0261070 A1	MILLER et al.	12-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **1-2, 4-8, 10-11, 13, 15-19** and **21-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuster, Pub. No. US2005/0097059 A1 in view of Miller et al, Pub. No. US2004/0261070 A1, hereinafter referred to as Shuster and Miller, respectively.

As per **Claims 1, 5-7, 10, 16-17, 22 and 25**, Shuster discloses a licensing system and method comprising:

- computing a licensing fee for the target software based on the quality value (0013, 0015, 0037-0038).

Shuster fails to disclose a processor that stores operation logs of a target software, measures a performance level of the target software based on the operation logs; and determine a quality value for the target software based on the performance level. Shuster however does disclose measuring the quality of digital content and determining the licensing cost based on the quality of the digital content. Moreover, Miller teaches storing the pertinent monitoring data and determining the performance of the software where the software's performance is based on many performance characteristics (0007, 0018, 0028-0029). Therefore, it would have been obvious to

one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and store and monitor the performance data of the software being tested as taught by Miller, because it allows the system to license better quality software at a higher rate.

As per **Claims 2, 4, 18-19, 23 and 26**, Shuster fails to disclose comparing the performance of the target software to performance of another software. However, Miller teaches comparing the performance of the software to determine if it met an expected performance (0007). The expected performance comes from previous versions of the software being tested. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include comparing the target software to another comparable software as taught by Miller, because it allows the system to set benchmarks for comparison.

As per **Claim 8**, Shuster fails to disclose computing an absolute value for the quality value. However, Miller teaches monitoring the performance of the software to determine the number of defects per hour (0028-0029). Further, it is old and well known in the art at the time of the applicant's invention to provide comparison values in terms of absolute values. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include providing values in terms of an absolute value, because it allows the system to provide the user with comparison data in numerical terms.

As per **Claim 11**, Shuster fails to disclose determining a quality value based on a factor selected from the group consisting of accuracy level… However, Miller teaches determining a quality value of the software based on a performance level (0028). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include determining a value of the software based on one of several characteristics as taught by Miller, because it allows the system to evaluate the software on many aspects of performance.

As per **Claims 13, 15, 21, 24 and 27**, Shuster fails to *explicitly* disclose adjusting a base licensing fee based on the quality value. However, Shuster discloses computing a price for a license for the downloaded file based on the measured metrics. For example, the price would be higher for a newer version of the file than the earlier version (0038). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include adjusting the license fee based on the quality of the file, because it allows the system to charge a higher fee for better quality digital content.

3. Claims **3, 9, 12, 14** and **20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuster in view of Miller as applied to claims 1 and 16 above, and further in view of Official Notice.

As per **Claims 3, 9, 14 and 20**, Shuster fails to disclose dividing an error rate associated with the other software by an error rate associated with the target software; and multiplying the quality value by a first constant and adding the result to a second constant. However, Miller

teaches error rates (0028-0029). Further, the Examiner takes Official Notice that it is old and well known in the art at the time of the applicant's invention to compare values by dividing them, or to use mathematical operations to manipulate values. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include using mathematical operations to compare and manipulate values, because it allows the system to compare values.

Furthermore, the difference between determining performance metrics of software as disclosed by Shuster and Miller, and the specific components of the applicant's disclosed system are only found in the non-functional descriptive material and are not functionally involved in the system components recited. The dividing of error rates or multiplying values by constants would be performed the same regardless of the descriptive material since none of the components explicitly interact therewith. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to include any specific manipulation of values because such data does not functionally relate to the components in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per **Claim 12**, Shuster fails to disclose computing a value based on at least one point measurement over a timeframe that is substantially equal to or less than a predetermined time period. However, the Examiner takes Official Notice that it is old and well known in the art at the time of the applicant's invention to test software over an extended period of time in order to determine software issues. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include testing data over an extended period of time, because it allows the system to determine the software's quality and performance over a period of time where many of the software issues can become apparent.

(10) Response to Argument

First Issue

Appellant argues that the combination of Shuster and Miller cannot be used to reject the claims because Shuster and Miller cannot be combined. Appellant goes on to argue that Shuster does not teach or even suggest actually performing the digital music file to measure metrics or to determine the price for a license. Examiner notes that in the broadest reasonable interpretation, Shuster's teaching that other defects in the copy, such as background hiss indicating that the data has once been stored in analog, or encoding defects such as pops may also influence the price calculation…thus, the licensing program is able to calculate a price for a license based on the measured metrics (0038), teaches determining a quality value for a target software based on performance of the target software. Further, in response to appellant 's argument that the cited references cannot be combined, the test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

It can be seen that each element claimed is taught by either Shuster or Miller. For instance, Shuster discloses the appellant's claim 1 limitation, "computing a licensing fee for target software based on the quality value. Shuster discloses calculating a fee for a license for the digital copy by the at least one computer program. The step of calculating includes the step of measuring at least one metric of the digital copy (0013, 0015, 0027-0038). Furthermore, Miller teaches the appellant's claim limitation, "determining a quality value for a target software based on performance of the target software." Miller teaches performance is automatically monitored based on predetermined monitoring criteria…the data is automatically analyzed to determine if the actual performance of the software version met an expected performance (0007, 0018). Moreover, Miller teaches the monitoring system collects data relating to one or more performance characteristics, such as reliability (e.g., how many defects are found); availability....(0028-0029). Monitoring for performance characteristics (taught by Miller) does not change nor affect the normal functions of license fee calculation as taught by Shuster. Calculating license fees for a digital copy would be performed the same way even with the addition of monitoring performance characteristics. Since the functionalities of the elements in Shuster and Miller do not interfere with each other the results of the combination would be predictable.

Furthermore, known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art. Similarly, in the Leapfrog Enterprises, Inc. v. Fisher-Price, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007) infringement case, the question to resolve was whether it was obvious to update the prior art mechanical device that made sounds of letters printed on puzzle pieces when puzzle pieces were pressed by applying modern electronics to achieve the same result. The answer was yes. In the current case, Shuster discloses a licensing program running on the server computes a price for a license for the downloaded file. Specifically, the licensing program computer a price based on the measured metrics....Other defects in the copy, such as background hiss indicating that the data has once been stored in analog, or encoding defects such as pops may also influence the price calculation. Thus, the licensing program is able to calculate a price for a license based on the measured metrics (0038). Miller teaches a monitoring system which monitors software performance (0028-0029). Thus, both Shuster and Miller were concerned with performance metrics of the digital copy. Further, Shuster discloses a licensing program which calculates a price for a digital copy. For example, if the MPS3 music file has a sampling rate that is below 32kbps, then it may be licenses for free (e.g., the better the quality of the digital copy the more that can be charged) (0038). Therefore, Shuster discloses an incentive for better quality digital copies. Seeing as Shuster discloses a conscienceware program measures various metrics of the downloaded file in order to determine a fair price for a license and Miller also teaches monitoring performance metrics, one or ordinary skill in the art would have that combination of Shuster and Miller predictable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Fadey S. Jabr

/F. S. J./
Examiner, Art Unit 3628

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